

REMARKS

In the Office Action, the Examiner rejected all pending claims 1-15 and 21-27. In view of the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

Claim Rejections under Doctrine of Obviousness-Type Double Patenting

In the Office Action, the Examiner rejected claims 1-4, 6, 7, 9-15, and 21-27 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over (i) claims 1-25 of U.S. Patent No. 6,239,235, (ii) claims 1-19 of U.S. Patent No. 6,806,324, (iii) claims 1-9 of U.S. Patent No. 6,743,869, and (iv) claims 1-13 of U.S. Patent No. 6,815,511. Although Applicants do not agree that the present claims 1, 3, 4, 6, 7, 9-15, and 21-27 are obvious over the claims cited by the Examiner, Applicants will consider filing a terminal disclaimer if necessary when the present claims are indicated as allowable.

Improper Combination of Rejections

Further, Applicants note that the Examiner formulated both (1) a double-patenting rejection based on Hottovy, U.S. Patent No. 6,239,235 and (2) a rejection under 35 U.S.C. § 102(b) based on the same Hottovy, U.S. Patent No. 6,239,235. *See* Office Action, pages 2-4. This is improper. *See, e.g.,* M.P.E.P. § 804 II.B.1, p. 800-22, first column (August, 2001 and Rev. 2, May 2004). Applicants noted this error in the previous response. Applicants respectfully request that the Examiner remedy this improper combination of rejections.

Claim Rejections under 35 U.S.C. § 112, First Paragraph

The Examiner rejected claims 5 and 8 under 35 U.S.C. § 112, First Paragraph, for failing to comply with the enablement requirement. The Examiner asserted that the “claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art . . . to make and/or use the invention.” Office Action, page 2. In particular, with regard to both claims 5 and 8, the Examiner stated that “[t]he base of the percentage of monomer is not defined.” See Final Office Action, page 2. Further, the Examiner contended that the phrase “a range of concentration” recited in claim 5 should be corrected to more clearly indicate this phrase refers to the “variation” of monomer concentration. Applicants respectfully traverse these rejections.

Legal Precedent

Regarding the enablement requirement, the Examiner has the initial burden to establish a *reasonable basis* to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993). The test for enablement, as set forth by the Supreme Court, is whether the experimentation needed to practice the invention is undue or unreasonable? *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916). The *undue experimentation* test essentially evaluates whether one of reasonable skill in the art can make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. *U.S. v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988). A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 U.S.P.Q.2d 1331, 1332 (Fed. Cir. 1991).

Claims 5 and 8

As mentioned, the Examiner contended that claims 5 and 8 are not enabled because “the base of the percentage of the monomer is not defined.” *See* Final Office Action, page 2. Applicants respectfully traverse this contention. The base of the percentage of monomer (e.g., ethylene) is defined. *See, e.g.*, Specification, Examples I and II, pages 11 and 12, ¶¶ 36 and 27 (explaining that to calculate the percent ethylene, the “pounds of ethylene” in the reactor are divided by the “pounds of the liquid contents in the reactor”). Indeed, the monomer concentration is expressed as a weight percent of the liquid contents in the reactor. *See id.*

The Examiner acknowledged this definition but contended that “such [a] limitation must be inserted into the claims in order to overcome the rejection.” Applicants respectfully traverse this contention. Again, the calculation basis of the monomer (e.g., ethylene) concentrations in percent is clearly described in the specification and need not be expressly stated in the claims. One only need to look to the specification and to what is known by one of ordinary skill in the art to straightforwardly understand the subject matter of claims 5 and 8. *See Phillips v. AWH Corp.*, No. 03-1269, -1286, at 13-16 (Fed. Cir. July 12, 2005); *Collegenet, Inc. v. ApplyYourself, Inc.*, No. 04-1202, -1222, 1251, at 8-9 (Fed. Cir. August 2, 2005) M.P.E.P. §§ 608.01(o) and 2111.

Claim 5

Claim 5 expresses the swing in monomer concentration as an absolute difference in percentage (e.g., 1.05%), a well-known methodology in the art. *See* page 2, ¶ 8. *See, e.g.*, Specification, Specification, page 6 ¶¶ 19 and 29; pages 11 and 12, ¶¶ 36 and 27. The Examiner asserted that claim 5 must be amended to make more clear that the swing percentage presented in

claim 5 refers to the difference in concentration through the loop reactor (and not directly to the actual concentration). However, in view of the specification, Applicants respectfully assert that the claim 5 is clear to one of ordinary skill in the art, and is enabled. For these reasons, Applicants respectfully request that the Examiner withdraw the rejection of claim 5 under 35 U.S.C. § 112.

Request Withdrawal of Rejection

In view of the foregoing, undue experimentation is *not* required by one of ordinary skill in the art to make and use the presently-claimed invention. *See, e.g., U.S. v. Telectronics, Inc.*, 857 F.2d at 778. Claims 5 and 8 are enabled. Accordingly, Applicants respectfully request that the Examiner withdraw the rejections of claims 5 and 8 under 35 U.S.C. § 112, and allow the claims.

Claim Rejections under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1-4, 6, 7, 9-15, and 21-27 under U.S.C. § 102(b) as anticipated by Hottovy et al. (U.S. Patent No. 6,239,235) and rejected claims 1-15 and 21-27 are rejected under 35 U.S.C. 102 (e) as being anticipated by Kendrick et al. (US 2002/0173598 A1, now US Patent No. 6,833,415). Claims 1 and 24 are independent. Applicant respectfully traverses these rejections.

Legal Precedent

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir.

1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). The prior art reference must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Deficiencies of the Rejection based on Hottovy

Independent claim 1, as amended, recites “introducing an olefin monomer to a loop reaction zone through a plurality of monomer feeds, *wherein the monomer feeds are substantially symmetrically arranged around the loop reaction zone.*” (Emphasis added). Independent claim 24 recites “wherein the monomer feeds and the product take-offs are arranged *substantially symmetrically* about the loop reactor.” (Emphasis added). In contrast, Hottovy is absolutely devoid of arranging monomer feeds and/or product take-offs substantially symmetrically about the loop reactor. Therefore, Hottovy cannot anticipate claims 1 and 24, or their dependent claims.

In the Final Office Action, the Examiner asserted incorrectly that two feeds (or two take-offs) would *always* be symmetrical about the loop reactor. The Examiner contended that such symmetry is at least “C₂ symmetry,” a term generally used in the molecular arts and inapplicable to the present claims. The phrase “C₂ symmetry” is used to describe the mirror plane symmetry associated with molecules and their isomers. Contrary to the Examiner’s assertion, two feeds, for example, will not always be symmetrical. This is so when even considering the concept of

the inapplicable C₂ symmetry. In other words, the multiple dissimilar segments of the loop reactor make clear that two feeds will *not* always be symmetrical or resemble the irrelevant molecular mirror symmetry (i.e. where rotated 180°).

In view of these reasons, Applicants respectfully request that the Examiner withdraw the foregoing rejection under 35 U.S.C. § 102 and allow the claims.

Request Removal of Kendrick

Kendrick is not valid prior art because Applicants, in a previous Response (which is herein incorporated by reference), elected to remove Kendrick et al. (US 2002/0173598 A1, now issued as US 6,833,415) under 37 C.F.R. § 1.131. *See* Response to Final Office Action Mailed February 24, 2005, pages 10-17. Again, Applicants respectfully assert that the previously-submitted Rule 131 Declaration and the accompanying exhibits sufficiently establish an earlier date of the invention of the subject matter disclosed and claimed in the present application. *See* Rule 131 Declaration of Donald W. Verser; Exhibits C, D, and E. These documents establish conception prior to the effective dates of the cited reference and, furthermore, establish diligence during the critical period from just prior to the effective date of the cited reference until constructive reduction to practice of the present application. *See* 37 C.F.R. § 1.131(b); M.P.E.P. §715.07(III). Therefore, Applicants believe that the cited reference should be removed pursuant to 37 C.F.R. § 1.131.

Applicants Decline to Provoke an Interference with Kendrick et al. (US 6,833,415)

With regard to Kendrick et al. (US 6,833,415), Applicants believe the appropriate path is to removed the Kendrick et al. (US 6,833,415) via the previously-submitted Rule 131 Declaration, as discussed above. If the Examiner disagrees with Applicants and believes that “the reference is claiming the same patentable invention,” and therefore, the previously-submitted “declaration of June 27, 2005 is inappropriate under 37 CFR 1.131(a),” it is the Examiner’s responsibility to initiate the interference, not Applicants. *See* M.P.E.P. Chapters 800 and 2300; Office Action, pages 4-5.

The Examiner must either remove the reference under 37 C.F.R. § 1.131 or provoke an interference. *See* M.P.E.P § 2306. Applicants note that if the Examiner provokes an interference, the Examiner is required to suggest claims for the interference. *See* M.P.E.P. Chapter 2300.

Request Evidence to Support Official Notice

Further, dependent claim features (e.g., with regard to the separate control of monomer feeds, the unimodal production, etc.) are *not* within the generic disclosure of the prior art, as incorrectly asserted by the Examiner. *See* Office Action, page 3. Indeed, the present claims recite unique features not found in the prior art at least with regard to such subject matter. The Examiner asserted that these features are known and understood in the art. *See* Final Office Action, pages 3-4. Thus, the Examiner has essentially taken Official Notice of facts outside of the record that the Examiner apparently believes are capable of demonstration as being “well-known” in the art. *See id.* Moreover, Applicants emphasize that the subjected matter of the

present claims is not of a “notorious character” and are clearly not “capable of such instant and unquestionable demonstration as to defy dispute.” *See* M.P.E.P. § 2144.03.

Therefore, in accordance with M.P.E.P. § 2144.03, Applicants hereby seasonably traverse and challenge the Examiner’s use of Official Notice. Specifically, Applicants respectfully request that the Examiner produce evidence in support of the Examiner’s position as soon as practicable during prosecution and that the Examiner add a reference to the rejection in the next Official Action. If the Examiner finds such a reference and applies it in combination with the presently cited references, Applicants further request that the Examiner specifically identify the portion of the newly cited reference that discloses the allegedly “well known” elements of the instant claim, as discussed above, or withdraw the rejection.

Conclusion

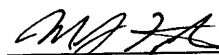
The Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Authorization for Extensions of Time and Payment of Fees

In accordance with 37 C.F.R. § 1.136, Applicants hereby provide a general authorization to treat this and any future reply requiring an extension of time as incorporating a request thereof. The Commissioner is authorized to any fees which may be required to advance prosecution to Deposit Account No. 06-1315; Order No. CPCM:0023/FLE.

Respectfully submitted,

Date: March 20, 2006



Michael G. Fletcher
Reg. No. 32,777
FLETCHER YODER
P.O. Box 692289
Houston, TX 77269-2289
(281) 970-4545